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FORT COLLINS, CO 80528

In re Application of: HILDEBRANT, et al. )  
Application No. 10/736,438 ) DECISION ON PETITION FOR  
Attorney Docket No. 10030775-1 ) SUPERVISORY REVIEW  
Filed: 12/15/2003 ) UNDER 37 CFR §1.181  
For: SYSTEMS AND METHODS FOR )  
ADAPTIVELY COMPRESSING TEST )  
DATA )

This is a decision on the petition under 37 CFR § 1.181, filed November 7, 2007, requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the final Office action mailed August 7, 2007.

The petition is **GRANTED**.

**RECENT PROSECUTION HISTORY**

- (1) On March 16, 2007, a non-final Office action was mailed. Claims 1-32 were pending, all claims were rejected on prior art.
- (2) On June 14, 2007, a response to the non-final Office action, in which amendment to pending independent claims 1, 12, 17 and 28, was filed. Claims 2, 14, 18 and 30 were cancelled.
- (3) On August 7, 2007, a final Office action was mailed which appeared to treat all of claims 1-32. The Examiner made this Office action final.
- (4) On October 5, 2007, a proposed amendment and response after final (37 CFR § 1.116) was filed.
- (5) On October 19, 2007, an advisory action was mailed indicated the proposed amendment would be entered for purposes of appeal.
- (6) On November 7, 2007, the instant petition was filed, along with a Pre-Appeal Brief Request for Review and a Notice of Appeal.

## RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the withdrawal of the finality of the August 7, 2007 office action.

## ANALYSIS

The relevant sections of the M.P.E.P. are set forth below:

MPEP § 706.07(a) states in part that:

Under present practice, second or any subsequent action on the merits shall be made final, except where the examiner introduces a new ground of rejection *not necessitated* by amendment of the application by the applicant, whether or not the prior art is already of record. Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will *not be made final* if it includes a rejection, on newly cited art ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

MPEP § 706.07(d) states in part that:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

MPEP § 706.07(e) states in part that:

When a final rejection is withdrawn, all amendments filed after the final rejection *are ordinarily entered*.

## CONCLUSION

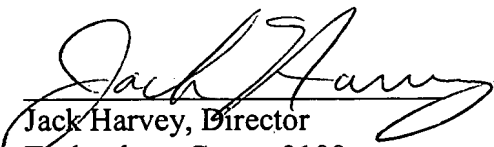
A review of the prosecution record reveals that the Applicant's amendment to independent claims 1, 12, 17 and 28 after the non-final action on the merits mailed March 16, 2007 did not necessitate a new grounds of rejection made in the final Office action, as the amendment represents the limitations of now cancelled dependent claims 2, 14, 18 and 30 added to independent claims 1, 12, 17 and 28, respectively. In particular, dependent claims 14 and 30 were previously rejected under 35 USC 103(a) as being unpatentable over Ishida and further in view of Wang et al. (US Pub. 2006/0242502) (see non-final Office action, para. 20, of March 16, 2007). Their respective claim limitations having been added to independent claims 12 and 28 respectively, claims 12 and 28 are now currently rejected under 35 USC 102 (e) as being anticipated by Ishida (see final Office action, para. 2, of August 7, 2007). Petitioner's statement in support of the instant petition regarding the confusion with respect to the appropriate grounds of rejection regarding pending claims (in particular, claims 12 and 28) is well-taken.

By merely cancelling dependent claims and adding their limitations to their corresponding independent claims, the amendment filed June 14, 2007 represents a proper amendment under 37 CFR § 1.111.

For the above stated reasons, the petition to withdraw the finality of the final Office action of August 7, 2007 is **GRANTED**.

The application file is being forwarded to the technology support staff to **WITHDRAW** the finality of the previous Office action and to **ENTER** the amendment and response filed October 5, 2007, and to **PROCESS** the papers filed November 7, 2007. The file will then be forwarded to the Examiner for appropriate action and prompt consideration of the amendment of October 5, 2007 and the response filed November 7, 2007.

Any inquiries related to this decision may be directed to Quality Assurance Specialist Brian Johnson at (571) 272-3595.

A handwritten signature in cursive script, reading "Jack Harvey". The signature is written in black ink and is positioned above the printed name and title.

Jack Harvey, Director

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